

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/852,336

First named inventor: James Duncan Work

Filed: 5/8/2001

Art Unit: 2153

Examiner: Chca, Philip J.

Confirmation No.: 4814

Title: Method and Apparatus for Internet-based
Human Network Brokering

Commissioner for Patents
P.O. Box 1450
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REPLY BRIEF (37 CFR 41.41)

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed February 28, 2008.

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I. REAL PARTY IN INTEREST

The real party in interest is now the inventor, James Duncan Work.

II. STATUS OF CLAIMS

Claims 1-147, 153, 154, 157, 159, 160 and 163-171 have been cancelled. Claims 148-152, 155, 156, 158, 161, 162 and 172-178 are currently pending, have been finally rejected, and are the subject of this appeal.

III. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1) Claims 148, 150, 155-156, 158, 172, 174, and 177-178 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Michalski (“Collaborative Filters”).

2) Claims 149, 173 and 175-176 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Michalski (“Collaborative Filters”) in view of the general level of skill in the art.

3) Claims 151-152 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Michalski (“Collaborative Filters”) in view of Kautz et al. (“The Hidden Web”).

4) Claims 161-162 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Michalski (“Collaborative Filters”) in view of Walker et al., U.S. Patent No. 5,884,270.

IV. ARGUMENT

Michalski does not provide an enabling disclosure with respect to each and every limitation of the claims, and therefore cannot serve as a basis for rejecting the present claims.

All of the present rejections of the claims are based, to one degree or another, on the disclosure provided in the Michalski reference. In the case of claims 148, 150, 155, 156, 158, 172, 174, 177 and 178, Michalski is said to anticipate the claimed invention. But, to *anticipate* a claim, the identical subject matter must not only be previously known, the knowledge must be sufficiently enabling to place the information in the possession of the public.

In *Seymour v. Osborne*, 78 U.S. 516 (1870), the Supreme Court explained:

Patented inventions cannot be superseded by the mere introduction of a [prior art reference] unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art of science to which it appertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defense, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and carry it into practice use. Whatever may be the particular circumstances under which the publication takes place, the account published, to be of any effect to support such a defense, must be an account of complete and operative invention capable of being put into practical operation.

78 U.S. at 555 (*emphases added*). This principle has been illustrated with respect to many areas of technology. See, e.g., *Elan Pharmaceuticals, Inc. v. Mayo Foundation*, 346 F.3d 1051, 1054-55 (Fed. Cir. 2003) (transgenic animals - anticipation requires enablement, whereby the reference “must teach one of ordinary skill in the art to make or carry out the claimed invention without undue experimentation.”); *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339 (Fed. Cir. 2000) (masonry ties - a prior art reference that does not enable a person of ordinary skill in the art to practice the claimed invention does not anticipate the patent claims); *Akzo N.V. v. United States Int’l Trade Comm’n*, 808 F.2d 1471, 1480 (Fed. Cir. 1986) (a process for making aramid fibers - anticipation requires that the reference publicly discloses all elements of the claimed invention and enables its practice); *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 665 (Fed. Cir. 1986) (an automatic passenger fare charging system - a non-enabling publication is insufficient to

anticipate claims). In each case, the question to be answered is whether or not the disclosure provided by the reference placed the invention in the hands of one of ordinary skill in the art. In *re Donohue*, 766 F.2d 531, 533 (Fed.Cir.1985).

Viewed under this standard, it is clear that the Michalski reference does not provide an enabling disclosure of the presently claimed invention. The sum total of the disclosure relied upon by the examiner is contained in approximately six and one-half paragraphs of text at page 15 of the cited reference. In these few sentences, Michalski reports on an interview he conducted with the named inventor of the instant application, Work. This report can be summarized as follows:

Paragraph 1: Michalski introduces the concept being investigated by Work by posing a rhetorical question: what if one could use systems similar to those used for rating inert items instead to focus on people? He recognizes that certain features (safeguards against inappropriate use of information and incentives for participating) would have to be provided, but does not suggest how those problems can be addressed. Recognizing a problem does not provide an enabling disclosure.

Paragraph 2: Michalski identifies the present inventor, Work, as someone working on solving these problems. Identifying an investigator is not an enabling disclosure of the kind needed to anticipate the present invention.

Paragraph 3: Michalski describes the Net Deva system as a sort of “collaborative filter” made up of software agents used for “collecting, linking and automating multiple annotated Rolodexes over the Net”. This brief description provides only the most limited insight into how such a system is architected and certainly does not describe in any fashion that would allow one of ordinary skill in the art to recognize the presently claimed methods in which access control criteria are selectably controllable by persons in a chain of person-to-person relationships and access levels are defined in terms of attributes of relationships that exist between such persons (claim 148) or a connection strength attribute of access control criteria that are selectably controllable by persons in a chain of person-to-person connections between the searcher and the potential target (claim 172).

Paragraph 4: Some details regarding personal search agents, gatekeeper agents and network broker agents are provided. Personal search agents are described as those that look for

likely partners and that make requests of gatekeeper agents of likely prospects. Gatekeeper agents are said to manage information access by evaluating the relevance of requests and checking validity and trust levels of the agents making those requests.¹ Network broker agents are described as helpers that introduce people. None of this discussion even hints at the presently claimed methods in which access control criteria are selectably controllable by persons in a chain of person-to-person relationships and access levels are defined in terms of attributes of relationships that exist between such persons (claim 148) or a connection strength attribute of access control criteria that are selectably controllable by persons in a chain of person-to-person connections between the searcher and the potential target (claim 172). For example, there is no teaching or suggestion of any selectably controllable access control criteria being involved in the system, indeed no discussion of access levels at all, other than a vague indication that gatekeeper agents must check trust levels of personal search agents. Certainly, this nondescript reference, with no follow up, cannot be said to provide sufficient information for one of ordinary skill in the art to have possession of the presently claimed method in which access control criteria are selectably controllable by persons in a chain of person-to-person relationships and access levels are defined in terms of attributes of relationships that exist between such persons.

Paragraph 5: This passage starts with an assumption -- if Work were able to build a user community with certain characteristics, then perhaps the Net Deva system would offer an environment in which those people might share information with one another. This portion of the discussion offers no enabling disclosure relevant to the presently claimed methods. The final two sentences of paragraph 5 do give further information regarding the architecture of the system and indicate that network brokers only receive information if permitted by gatekeeper agents, which are able to dole out such information according to varying levels of security based on levels of trust.

These two sentences are worthy of further examination inasmuch as it is largely on the basis of these sentences that the Examiner has based his rejections. The subject passage reads:

Personal information is available to the network broker, but not to individuals, unless it is specifically allowed by the guarding gatekeeper. Personal gatekeeper agents are able to give access at varying levels of security, based on levels of trust.

¹ It is worth noting that terms such as “levels of security”, “levels of trust”, “gatekeeper agent” and “network broker” are not defined or explained in the Michalski article. The Examiner has not cited any other information to describe the state of the art at the time of the Michalski reference, therefore, it is by no means clear that the use of such terms is analogous to the use of different terms in the present claims.

Collectively, these two sentences indicates that information is always available to the network broker agents, but only provided to human users of the system if the gatekeeper agents so permit and then at varying levels of security based on levels of trust. Viewing this information in the light most favorable to the Examiner's position, one could conceivably describe "trust" as an attribute of a relationship. Therefore, one of ordinary skill in the art could perhaps have understood that some form of relationship attribute could be evaluated to determine what information to share. But even this would not yield the present invention because there would still be no information in the reference alluding to the need for the access control criteria to be selectably controllable by persons in a chain of person-to-person relationships are recited in claims 148 and 172, and, further, no notion of a connection strength threshold as recited in claim 172.

Paragraph 6 offers a comparison of the Net Deva system to other works, but provides no further enabling disclosure relevant to the presently claimed invention. Likewise, paragraph 7 offers nothing further in this regard and, indeed, notes that Work will have a challenge in actually bringing his vision to fruition.

In short then, the brief disclosure provided by the Michalski reference was insufficient to place the presently claimed invention in the hands of those of ordinary skill in the art. Consequently, these claims are patentable over that reference.

Michalski fails to teach or suggest the features of the present independent claims and, therefore, the claims are patentable over this reference.

As discussed above, claim 148 recites a method in which the access control criteria are "selectably controllable by any of one or more persons in one or more chains of person-to-person relationships connecting and including the searcher and the potential targets."² Michalski, even if it provides a sufficiently enabling disclosure, fails to describe such a method. Specifically, there is no mention of selectably controllable access control criteria and, consequently, claim 148 and its dependent claims are patentable over this reference.

² A system that purportedly combines Rolodexes to help people build teams, staff projects, make introductions and close deals as reported by Michalski does not necessarily suggest a system or method in which chains of person-to-person relationships are involved. No such chains are referred to in the passage cited by the Examiner, nor anywhere else in the Michalski article for that matter.

Claim 172 recites similar selectably controllable access control criteria and also states that matches to a search are reported when “a connection strength between each two people forming a person-to-person connection in a chain of person-to-person connections between the searcher and a potential target exceeds a connection strength threshold.” In addition to omitting any discussion of selectably controllable access control criteria, the Michalski reference does not disclose or suggest the use of a connection strength threshold. Therefore, claim 172 and its dependent claims are patentable over this reference.

V. CONCLUSION

For at least the foregoing reasons, the claims are patentable over the references cited in the Office Action. If there are any additional fees due in connection with this communication, please charge our deposit account no. 19-3140.

Respectfully submitted,

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